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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/820,254	03/18/1997	TAKAO SAWABE	041465-5034	2677

7590

12/04/2002

MORGAN LEWIS & BROCKIUS
1800 M STREET NW
WASHINGTON, DC 200365869

EXAMINER

ROBERTSON, DAVID L

ART UNIT

PAPER NUMBER

2186

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Docketed 12-6-02 Attorney JGS/RJH
Case 41465-5034-02
Due Date 3-4-03
Final Amendment due / NOTICE
By SDW Chk Ego Appeal Due

RECEIVED

DEC 06 2002

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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25

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 11/7/02

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 mos. month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 2187

This Office action is in response to the Amendment and the Petition filed November 7, 2002. This Office action includes a written statement by the examiner setting forth the reasons for his decision in the matters averred in the petition, see 37 C.F.R. § 1.181(c).

In the Office action of September 25, 2001 the examiner questioned the statement in the specification that reads:

It has recently been suggested that it may be possible to develop a DVD having ten times storage capacity of a conventional DVD without making it any larger than a conventional CD. (See substitute specification, page 2, lines 18-21.)

It their response, "Applicants respectfully maintain their belief that it has been proposed that it may be possible to develop a DVD having ten-times the capacity of a conventional DVD." (See remarks of March 25, 2002, paper number 18.) However, according to the certified translation of the priority document, the original statement reads:

There have recently been made extensive proposals and development of a DVD as an optical disk having an increased storing capacity by about ten times without modification in its own size in comparison with the aforementioned conventional CD. (See the certified translation, page 5, lines 18-22.)

Thus, the specification as filed, the specification as amended and the statement concerning applicants' belief are ALL inconsistent with the language of the certified English translation.

Please clarify.

Applicant's remarks, continuing to object to the requirement to label figures 1-6A as "Prior Art," are noted. The examiner has provided prior art documents that appear to teach both the physical and logical data structures that are shown in applicants' figures 1-6A. Applicants

Art Unit: 2187

MUST label figures 1-6A as "Prior Art" or provide specific examples of elements contained therein that are NOT prior art and an explanation. The examiner is not able to rescind this requirement merely because of "Applicants' good faith belief that not all of the subject matter depicted qualifies as 'prior art.'" Applicants' statements in the specification that the "explanations will be provided in the context of a DVD, to which the present invention may be applied" indicates that the invention is separate and distinct from the particulars of a DVD but may be practiced within the context of a DVD, suggesting that as envisioned at the time of filing, the present invention was intended to apply to other types of recordings (see page 11, lines 3-5). Applicants' statement that the "GOP 52...is determined by a standard based on the MPEG (Moving Picture Experts Group) 2 method" clearly states that the standard applied (i.e., MPEG2) was not invented in connection with applicants' present invention (see page 15, lines 5-11). In any event, absent any showing to the contrary, the particulars of figures 1-6A are prior art to applicants.

Applicants' explanation of "separately recorded" is insufficient. Using applicants' definition (i.e., its plain and ordinary meaning), the sentence on page 6, lines 4-6 becomes: *Here, "recorded together as a single minimum unit" means that the elements of the data group are recorded together.* This resulting definition is circular and therefore indefinite. This explanation does not overcome the objection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

Art Unit: 2187

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The amendment filed March 25, 2002 (and previous amendments, as well) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added

Art Unit: 2187

material which is not supported by the original disclosure is as follows: The reference to varying the order of reproduction has replaced what was previously described as “variegated reproduction.” Applicants state that they were unable to locate any instance of “the order of reproduction.” The quote was not a literal quote, but rather a summary of what the originally filed term *variegated* has evolved into. To facilitate the understanding of the objection, the progression of the to new matter will be outlined from the beginning. As originally filed, the last sentence of the paragraph beginning what is now page 17, line 19 read:

By performing the reproduction on the basis of a later described logical structure for each of these divisions, the variegated reproduction can be performed. (See originally filed specification, page 18, lines 18-21.)

This sentence was subsequently amended in paper number 5 (filed December 22, 1998) to read:

By performing the reproduction on the basis of a later described logical structure for each of these divisions, the reproduction can be performed in various ways. (See paper number 5, page 1, line 12-page 2, line 1.)

The above change constitutes new matter. In the substitute specification, paper number 14, filed February 12, 2001 the sentence became:

By performing the reproduction using the logical structure described herein for each of these divisions, dynamically variable reproduction can be performed. (See page 17, line 22-page 18, line 2.)

The above change constitutes new matter. This same sentence was further modified by paper number 18, filed March 25, 2002 to read:

By performing the reproduction using the logical structure described herein for each of these divisions, the order in which video and audio information recorded

Art Unit: 2187

on the DVD is reproduced may be varied. (See paper number 18, page 4 lines 13-15.)

The above change constitutes new matter. Interestingly enough, a certified English translation of the priority document accompanied paper number 18. The corresponding sentence therein is as follows:

By performing the reproduction on the basis of a later described logical structure for each of these divisions, the variegated reproduction can be performed. (See the certified English translation, page 19, lines 16-19.)

There is also a substitute paragraph filed in paper number 23 (November 7, 2002) that includes the subject sentence. However, this sentence is not modified by the replacement paragraph.

From the above sequence, it is abundantly clear that *variegated reproduction* (the meaning of which has never been adequately explained) has evolved into *varying the order of reproduction* which was NOT a part of the specification as originally filed. Every amendment from paper number 5 on represents new, and changing, matter. Applicant is required to cancel the new matter in the reply to this Office action.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant is reminded of 37 C.F.R. 1.75 (d)(1) which states:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

Art Unit: 2187

Claims 1-2, 6-8, 12, 14 and 16 do not have clear support or antecedent basis in the specification for the *terms and phrases* “a plurality of data groups”, “a first data group”, “a second data group” “a plurality of first information units” and “a plurality of second information units.” Applicants should use the terminology “video title set” or “VTS” as described, which does find support in the description. Claims 2-4 do not have clear support or antecedent basis in the specification for the *terms and phrases* “first calculating means”, “first judging means”, “second calculating means”, “second judging means” and the “second recording means”. Further, the *terms and phrases* “data-amount detecting means,” “first calculating means,” “first judging means,” “second calculating means,” “second judging means” and the “second recording means” do not appear to relate to anything in the specification at all, thus these claims fail to particularly point out and distinctly claim the invention. Due to the ambiguities and confusion in claims 2-4 and 14-15, no art has been applied thereto, see *In re Steele*, 49 CCPA 1295, 305 F.2d 859, 134 USPQ 292 (1962) and *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). The examiner will not speculate as to the intended meaning. In claim 8, applicants recite “a plurality of first information units” which appear, absent clear support or antecedent basis in the description, to correspond to the video title sets 3 of figure 1. Included in these video title sets are the video object units 30, shown in the lower portion of figure 3. Claim 8 then recites “a plurality of second information units” which appear to relate to video object units 30, separate and apart from those included in the “plurality of first information units”. The meaning and significance of these “second information units” is neither clear nor understood. Additionally, while the

Art Unit: 2187

placement of the first information units is specified, the placement of the second information units is not. For the purpose of applying art, the “plurality of data groups”, the “first data group”, the “second data group”, the “plurality of first information units” and the “plurality of second information units” were considered to be the video title sets 3 shown in figure 1 and VTS1 through VTS5 shown in figure 8.

Claims 1, 5 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by the laserdisc recording *Fantasia* (1940) released by Walt Disney Home Video. The laserdisc recording which is being relied upon in these rejections was released in laserdisc format in November of 1991 as indicated on the PTO-892. The (1940) designation indicates that the film version of the movie (i.e., 70mm film, sprocket holes on the edges, etc.) was released in 1940. The recording is properly referred to today with the (1940) designation to distinguish that particular production from the motion picture release of *Fantasia 2000* which was released in the year 2000. The rejections are not based on the content of the motion picture but rather on the formatting that was chosen when the work was released in the laserdisc format. Note that the change in Laserdisc titles is not an admission that the previous rejections in view of *Thumbelina* have been overcome. Rather, the *Thumbelina* reference was applied by the original examiner (Mr. Esteban A. Rockett) and is not available to the current examiner. The *Fantasia* recording includes a first recording layer (e.g., Side 1) that includes a first data group having at least video and audio information arranged as a minimum unit (e.g., any of chapters 1-5) and management information in a management information area (laserdiscs include a table of contents or “TOC

Art Unit: 2187

area”) recorded on the first recording layer; and a second recording layer (e.g., Side 2) that includes a second data group having at least video and audio information arranged as a minimum unit (e.g., any of chapters 6-9). Nothing in the body of the claims refers back to any of the particulars recited in the preamble of claim 1, thus the preamble is not limiting. Further, as is well known, 30 cm Laserdiscs which were recorded in constant linear velocity format have fixed capacities, generally of 60 minutes per side. Note that both the first and second layers (both CLV) include 39:11 (minutes:seconds) and 50:36 of programming, respectively, and therefore both sides include gaps between the lead-in and lead-out areas of the discs of approximately 20:49 and 9:24, respectively, where no data is recorded. (Side 3, on still another layer, has 30:01 of programming and a gap area of approximately 29:59.) Note that each side includes management information (TOC) for managing the respective data groups.

Claims 1 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Moriya *et al.* (U.S. 5,726,969). The Moriya reference teaches an optical recording medium for recording DVDs that includes a first information surface (e.g., 105, 305, 505) and a second information surface (e.g., 108, 308, 508) that are both accessible from the same side of the medium (see column 4, lines 6-12). The reference also teaches recording a plurality of branches (e.g., separate data groups having at least one of video information and audio information) on the two surfaces separately (see column 10, lines 24-26) and separate movies or different versions of the same movie (also separate data groups having at least one of video information and audio information) on separate surfaces (see column 12, lines 60-66).

Art Unit: 2187

Claims 1, 5-7, 8-13 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi *et al.* (U.S. 5,870,523) in view of Moriya *et al.* (U.S. 5,726,969). The Kikuchi reference teaches a DVD format for recording on a disc, where the data includes a management information area for managing all of the data on the disc (see figure 4, elements 70 and 71), a plurality of first information units (e.g., VTSs) where each includes control data (see Program Chain Information table 100, column 15, lines 55+); and object data (see figure 6, Video Objects 83). Note that each video object also includes a plurality of "second information units" including navigation information (see figure 6, NAV Pack 86) and at least one of video information, audio information and sub-picture information (see figure 6, V Packs 87 and 88, A Pack 91 and SP Pack 90; see also column 18, lines 5+). The reference does not teach the claimed particulars of the gap ranges, LI and LO areas (claims 5-7 & 9-10), that the first and second layer are accessible from a sing side of the disc (claims 13 and 17, and related to claims 1, 8, 12 & 16) or that the control data or program chain information is located at the forefront of the first information unit or video title set (claim 11). The Moriya reference has been discussed above. The reference further teaches that the two surfaces can be arranged to be logically contiguous (see column 10, lines 32-45). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the Kikuchi reference by recording the information shown in figure 4 (e.g., from the lead-in area 27 to the lead-out area 26) on a disc 101 as taught by Moriya, to provide an increased recording capacity without having to stop and turn the medium over (see Moriya, column 2, lines 13-27). This

Art Unit: 2187

would result in a disc with a first recording layer having a first data group including management information (areas 70 and 71) and at least one of video information and audio information (different branches, i.e., video title set #1, video title set #2, etc.) on one layer and a second data group having at least one of video and audio information (different branches, i.e., video title set # n-1, video title set # n, etc.) on a second recording layer, thereby providing a large recording space without the need to turn the medium over, thus the limitations of claims 13 and 17 are taught. Further, the Moriya reference clearly teaches placing one data group (e.g., VTS) completely on one side and another data group (e.g., VTS) completely on the other side, even if one is larger than the other (rather than placing an equal amount of data on each side without regard to the endpoints of each data group, see column 12, lines 62-66). The Kikuchi reference teaches having more than two data groups (e.g., VTSs). When placing the data from Kikuchi on the medium of Moriya, it follows that more than one VTS will be recorded on at least one of the recording layers. It is clear from the Kikuchi reference that more than one VTS may be placed on a given layer, thus to place more than one VTS on each of the surfaces of Moriya follows naturally; thus the limitations of claim 8 are also taught. Note that in the recording suggested above, it would start with a lead-in area 27 followed by the management information 70 and 71 on one surface, include at least one VTS, movie or branch (but possibly more) on that surface, continue to the other side with at least one VTS, movie or branch (but possibly more) on the second surface and end with a lead-out area 26, thus the limitations of claims 8 and 10 are also suggested. Note that Kikuchi teaches that the management information 70 and 71 manages all of

Art Unit: 2187

the VTSs on the disc (claims 12 and 16). Additionally, while the Kikuchi does not explicitly teach that the control data (e.g., program chain information) is at the beginning of the first information units (e.g., the beginning of each VTSs), it is clear that the control data must be read before the video objects can be reproduced (see Kikuchi, column 24, lines 7-60), thus it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have recorded the control data at the forefront of the first information of each of the first information units to facilitate the reproduction of the data to follow (claim 11). None of the reference teach gap ranges, or their relative placement. However, since the Moriya reference teaches recording two movies of different lengths on separate surfaces, and since the transition point from one surface to the other would obviously have been aligned in the radial direction (so that the transition from the end of one surface to the beginning of the other surface can take place merely by changing the focus depth (i.e., no seek is involved, see Moriya, column 10, lines 32-45). Further, as taught by Kikuchi, the lead-in and lead-out areas are physically located at the ends of the recording area where "no information is normally recorded", and are not placed in the information zone. Thus, it follows, that the information zones on both surfaces are co-extensive. Since Moriya teaches placing one set of data (e.g., branches or a movie) on one surface and a different set of data (e.g., branches or an edited version of the same movie) on the other surface, there will be at least one portion of the information zone of at least one of the surfaces that will not have any information recorded therein (e.g., a gap range). Further, since it is unlikely that any individual VTS or any grouping

Art Unit: 2187

of VTSs will exactly fill the entire information zone evenly. Thus, it is inherent that a DVD recording using the format taught by Kikuchi on a medium as taught by Moriya will include gap ranges on both surfaces, thus, the limitations of claims 5 and 9 have been met. As to the placement of the gap ranges, since the data on a DVD medium as described above is recorded in a CLV mode, and since the outer tracks of the disc are longer, per revolution, than the inner tracks, placing the data on the outer tracks results in fewer tracks being required for the same amount of data, thus the disc may be spun at a lower rate. However, since the volume file structure area 70 and the video manager area 71 include address tables to indicate the locations of all of the remaining files on the disc, and Kikuchi desires the disc to be compliant with various standards (see column 9, lines 57-59), the management information must be adjacent to the lead-in area. Because the management information would include addresses pointing to the locations of each of the remaining files, those remaining files may safely be placed at any arbitrary location on the disc. Thus, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have placed the management information adjacent to the lead-in area so that the address tables may readily be found by the reproducing system, and further, to have placed as much of the remainder of the data such that it is on the outermost tracks. This would inherently leave any gap ranges between the management information recorded adjacent the lead-in area on the innermost tracks and the VTSs on the outermost tracks on the first surface as claimed in claim 7 and between the VTSs on the outermost tracks on the second surface and the lead-out area on the innermost tracks on the

Art Unit: 2187

second surface as claimed in claim 6. Thus, the invention as claimed and described would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Applicants' arguments filed November 7, 2002 have been fully considered but they are not persuasive, except as noted below.

Applicants' admission, that techniques for detecting the size of a data file are well known, is noted. Therefore, the § 112 first paragraph "enablement" rejection of claims 2-4 and 14-15 has been withdrawn. Applicants' comments regarding the statutory requirements of § 112, first paragraph are persuasive, therefore the "enablement" rejection of claims 1-17 has been withdrawn.

Applicants' comments regarding the § 112, second paragraph rejection are not persuasive. First, applicants mis-characterize the meaning of 37 C.F.R. § 1.75(d)(1). The meaning of this rule is much more specific than that stated by applicant. The terms and phrases used in the claim or claims *must conform* to the language used in the specification and those terms and phrases *must find clear support or antecedent basis* in the description so that the meaning may be ascertained *by reference* to the disclosure. This is more than the *elements* of the claims having support, the rule clearly indicates that *the terms and phrases* used in the claims must have support or antecedent. Thus, it is imperative that a clear and unequivocal link must exist between the language, terms and phrases used in the description and those used in the claims. This clear and unequivocal link must exist within the description and the claims, i.e., it must be

Art Unit: 2187

self-contained. Applicants' glossary is interesting, but not persuasive. Applicants merely conclude that the listed terms find exemplary support in the description, but there is no showing of support. Further, it is noted that several of the terms and phrases used in the claims are alleged to correspond to the same element in the description, which is prima facie evidence that there is not clear support or antecedent for each of the terms. There is no support for the cited terms regarding data in figure 1 or the description, and there is no clear nexus between the "means" claimed and the elements of figures 5-7 and the corresponding description. Thus the 35 U.S.C. § 112, second paragraph rejection is proper and maintained.

With respect to the § 102(b) rejection, the comments regarding the effective date of the applied art has been addressed above. As to the comments regarding the structure of the recording, the disposition of the chapters is indicated on the packaging, and, according to applicants' description of the meaning of "separately recorded", it is clear that *all* of the data recorded on a first recording layer (e.g., side-1) is recorded together (i.e., not separately) and *all* of the data recorded on the second recording layer is also recorded together. Additionally, applicants' comments regarding the weight that must be given to the preamble are conclusory.

While applicants cite vague principles of case law, no specific decisions are mentioned, nor are the particulars of the claims and their preambles even discussed. As to the rest of applicants' § 102(b) arguments, they are essentially identical to the arguments filed March 25, 2002. They were not persuasive then, and are not persuasive now. Regarding the data groups and management information being recorded separately or homogeneously (whatever that means),

Art Unit: 2187

please indicate why it matters and how the language of the claim is being interpreted, particularly in view of applicants' explanation of "separately recorded."

With respect to the § 102(e) rejection, applicant's arguments are specious. They state that the art "does not appear to teach or suggest" followed by copious recitations of the claims, and other than alleging some sort of "algorithmic fashion," (which is not a part on any of the claims) again do not point to any particular defects or deficiencies of the rejection or to any distinguishing elements of the claims.

With respect to the § 103 rejection, applicants' arguments are incomplete. They quote a statement from the rejection (see page 14, lines 15-17), and then without further addressing the merits of the rejection, conclude that the claims are allowable. Additionally, while applicants point out that the Moriya reference is directed to a different problem than applicants' invention, nothing in the claims requires the essence of what applicants state is the invention (i.e., recording data so as to avoid the inevitable delay that accompanies a layer change). Further, the remaining arguments are also conclusory and misplaced. Conspicuously absent from the claims is any recitation of VTSs or the algorithm of figure 7. Thus the arguments are not persuasive.

Together with the amendment filed November 7, 2002; applicants also filed a petition under 37 C.F.R. § 1.182 requesting that portions of the previous Office action be expunged. This petition has been forwarded to the examiner to be considered as a "request for reconsideration" as provided by 37 C.F.R. § 1.181(c).

Art Unit: 2187

With respect to the examiners statement on page 2, line 3 of the previous Office action, no pejorative meaning was intended by reference to *obfuscate*. To obfuscate simply means "to confuse." For example, there is ample evidence that the DVD standard, which the application describes with reference to figures 1-6A, existed prior to applicants' Japanese filing date. First and foremost, is the language in the specification. The brief description of figure 1 states that it "is a descriptive view of a recording format...for recording video information and audio information on a DVD." This, coupled with the statement on page 11, lines 3-5 which reads "[the] following explanations will be provided in the context of a DVD, to which *the present invention may be applied*" (emphasis added) clearly suggests that the DVD format is NOT a part of applicants' invention. However, applicants' continued refusal to either point to particular elements that distinguish the figures from the evidence provided by the examiner or to label the figures as prior art clearly maintains confusion as to the distinction between what *is* applicants' invention and what *is not*, thus the use of obfuscate is appropriate. Further, as previously pointed out, the GOP of figure 2 is also shown in the Suzuki *et al.* patent, which applies as prior art under § 102(e). Applicant's response has been an offer to label figure 2 as "Related Art." However, the term "Related Art" does not have any established meaning with respect to patent practice. Thus the offer to place a meaningless label on figure 2 in an attempt to avoid labeling what clearly appears to be prior art as prior art, is in fact, an attempt to confuse the issue, or to obfuscate. The logical and physical layout of data on a DVD is shown in Kikuchi *et al.* which applies to this application as prior art under § 102(e). Applicants' response was to state that it is

Art Unit: 2187

their “belief that not all (if any) of that depicted in these Figures qualifies as ‘prior art’” without pointing to a single element therein. Applicants have merely repeated their “belief” in their latest response, again without providing any evidence that there is anything in applicants’ figures that is not prior art with respect to the Kikuchi reference. This continued lack of details and clarity confuses the issue further supports that applicants are obfuscating. Notwithstanding the arguments above, note the “History of Research and Development” that was posted by the assignee of the present application, which states that in the Autumn of 1995, “[the] industry finally agreed upon one unified format named Digital Versatile Disc (DVD).” This admission against interest further establishes that the DVD format predates applicants’ Japanese filing date by several months and their U.S. filing date by more than one year. The September 20, 1995 *USA Today* article *Supercharged digital video discs are on the way* suggests that this day was Friday, September 15, 1995. Yet Applicants continue to allege that they *believe* the format is not “prior art.” This is at odds with the assignee’s statements and is clearly obfuscation. Additionally, note the January 8, 1996 *USA Today* article *Consumer Electronics Show’s cutting edge//DVD’s new super spin on CD format* which states that Pioneer previewed the movie *Thumbelina*¹ on DVD at the Winter Consumer Electronics Show (CES). Since the Winter CES is held in January in Las Vegas, Nevada, this public use of the DVD format qualifies as prior art against applicants under §.102(b). Thus, the evidence that the DVD format, as described in

¹It seems ironic that this is the same title that was used in the first rejection of the present application, albeit in the laserdisc format.

Art Unit: 2187

figures 1-6A of the instant application, is prior art with respect to this application is impressive. For applicants to continue to deny that it is "prior art" undeniably qualifies as confusing the issue as to what is or is not "prior art" and is properly characterized as obfuscation. The comment in the previous Office action, however, is void of any suggestion that applicants have engaged in any improper conduct whatsoever. Thus, the comment is completely accurate, the examiner stands by it and sees no need for it to be withdrawn.

With respect to the comments regarding the § 1.105 request, again the examiner never states that applicants acted improperly nor suggests that applicants' statement regarding the requested document was an attempt to mislead. The comment was directed to applicants' objection to the examiner's reliance on the "proposed DVD standards and development." More particularly, in response to the rejection, applicants stated: "Accordingly, if this rejection is maintained, it is respectfully requested that the Examiner produce the relied upon 'proposed DVD standards and development.'" The examiner was merely expressing his good faith belief that the assignee does indeed have a copy of the proposed DVD standards and was pointing to the irony of applicants requesting this very same document from the examiner after the examiner had requested it from them. Support for the examiner's conclusion is based on the statements that were in the internet posting by C. Fogg (*A day at the DVD Forum: technical notes*), combined with the knowledge that the assignee was one of the principal members of the DVD Consortium and therefore, one of the authors of said document. This belief is now further reinforced by the assignee's internet posting regarding their R&D and the *USA Today* articles, all

Art Unit: 2187

as noted above. This belief is still further reinforced by both the response to the § 1.105 request and the most recent papers (including the petition) wherein neither the assignee nor the applicants deny that the assignee has a copy of the requested document. Thus, the examiner is justified in the conclusion stated in the previous Office action, that the assignee indeed does have a copy of the requested document. The § 1.105 request clearly stated the provisions of the rule that:

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

The examiner's comment also highlighted the difference between the language used by applicants in their response and the language of the rule as stated in the request. Applicants replied that "the document is not readily available to, and cannot be readily obtained." It is interesting to note, however that applicants did not respond that the document is unknown, nor that it could never be obtained. This further bolsters the examiner's belief that the document is known to the assignee, and that it may eventually be obtainable. This may be significant at some future time when the meaning of "readily available" may have been addressed in a precedential decision. However, the examiner never suggested that applicants' response is anything other than in compliance with the rule. Applicants' reply was treated as a complete response. No allegation of wrongdoing exists. The examiner cannot see any reason to expunge the noted comment.

Art Unit: 2187

Having discussed above the evidence regarding the existence of the DVD specification prior to applicants' effective filing date, note that 37 C.F.R. § 1.56 states:

Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section.

Note also that, unlike rule 1.105, this rule does not allow for the availability of a document to excuse compliance if the document is material to patentability. Since the DVD specification as it existed prior to applicants' effective filing date is clearly material to patentability (which can be seen by applicants' remarks, i.e., "Accordingly, if this rejection is maintained, it is respectfully requested that the Examiner produce the relied upon 'proposed DVD standards and development'"), applicants and their representatives have a duty to disclose said material to the Office regardless of the assignee's decision to the contrary.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

Art Unit: 2187

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this final action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7238, (for formal after final communications to Technology Center 2100; please mark "EXPEDITED PROCEDURE")

Or:

(703) 746-7240 (for informal or draft communications to Technology Center 2100, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the technology center receptionist whose telephone number is **(703) 305-3900**.

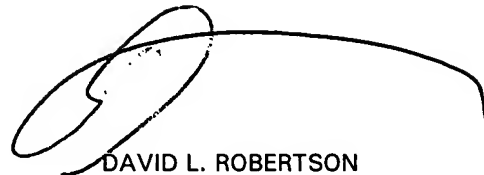
Direct any inquiries concerning-drawing review to the Drawing Review Branch (703) 305-8404.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Robertson whose telephone number is (703) 305-3825.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim, can be reached at 305-3821. **The fax number for Technology Center 2100 for Official communications is (703) 746-7239.**

Art Unit: 2187

Communications which are not application specific may also be posted on e-mail at
David.Robertson@USPTO.gov.

A handwritten signature in black ink, consisting of a large, stylized loop followed by a horizontal line extending to the right.

DAVID L. ROBERTSON
PRIMARY EXAMINER
ART UNIT 2186

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November 29, 2002